

REMARKS

Claims 2-20 are now pending in this application. Claims 3 and 4 are withdrawn. Claims 2, 5, and 6 are rejected. Claim 1 is previously cancelled. Claims 2, 5 and 6 are amended to place them in better form and/or to clarify the invention. New claims 7-20 are added.

Claims 2 and 5-6 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,305,194 (Budinski et al.) in view of JP 60-171234 (Shimizu et al.).

The Office Action states that Budinski et al. fails to teach an intermediate restrictor and the positioning of the restrictor with respect to the molding cores. The Office Action states that it would be obvious to combine Budinski et al. and Shimizu et al. in order to prevent the inclination of the molding die surfaces as taught by Shimizu et al.

To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). Claims 5 and 6 recite positioning the intermediate restrictor on the end part of the second molding core. The obviousness of such limitation has not been demonstrated over Budinski et al. in view of Shimizu et al. The inclusion of such limitation in Budinski et al. in view of Shimizu et al. would require not only the addition of the sliding core parts taught in Shimizu et al. but also that the dies disclosed

in Budinski et al. be modified. The Office Action has not addressed the modification of Budinski et al. in such fashion and no reason for such a modification to the invention of Budinski et al. has been made. The Supreme Court has explained the importance of identifying a reason to combine elements in the way the claimed new invention does. *See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). The Office Action has failed to demonstrate that the addition of the sliding core parts as taught in Shimizu et al. to Budinski et al. requires positioning the intermediate restrictor on the end part of the second molding core. The relative shapes of the molding cores in Budinski et al. are different than in Shimizu et al. and there is no reason to make the relative shapes of the molding cores in Budinski et al. the same as in Shimizu et al. The purpose of the sliding core parts of Shimizu et al. is to avoid the inclination of the molding die surfaces and their use does not require that the relative shapes of the molding cores have a particular configuration. Accordingly, it is Applicant's position that *prima facie* obviousness has not been demonstrated.

Claim 6 recites that the end part of the second molding core has a radially outer dimension that is larger than the radius of the opening of the intermediate restrictor. The obviousness of such limitation has not been demonstrated over Budinski et al. in view of Shimizu et al. In order for such a limitation to be present in Budinski et al., it would be required to add the sliding core parts taught

in Shimizu et al. and modify the dies disclosed in Budinski et al. The Office Action has not addressed the modification of Budinski et al. in view of Shimizu et al. in such fashion and no reason for such a modification to the invention of Budinski et al. has been provided. The Office Action has failed to demonstrate that the end part of the second molding core having a radially outer dimension that is larger than the radius of the opening of the intermediate restrictor is necessary in order to add the sliding core parts taught in Shimizu et al. to Budinski et al. The relative shapes of the molding cores in Budinski et al. are different than in Shimizu et al. and there is no reason to make the relative shapes of the molding cores in Budinski et al. the same as in Shimizu et al.

Furthermore, one of ordinary skill in the art would not utilize the sliding core parts 3L' and 3R' taught in Shimizu et al. in the invention of Budinski et al. The Office Action has not identified any disclosure in Budinski et al. disclosing that the inclination of the molding die surface is a problem or of any desire to modify the invention of Budinski et al. to include additional parts to prevent the inclination of molding die surfaces. Furthermore, Fig. 5 of Budinski et al. shows the molds with an induction heating coil 116 around them. If the sliding core parts 3L' and 3R' as well as the cylinder 4, which is necessary to move sliding core parts 3L' and 3R', were added to the invention of Budinski et al., this would interfere with the positioning of the heating coils. Furthermore, Budinski et al. discloses in column 4, lines 55-57 that "upper and lower mold halves 102, 104

preferably reside in a mold body." The addition of the sliding core parts 3L' and 3R' as well cylinder 4 would prohibit the addition of a mold body that has the mold halves within it since the sliding core parts 3L' and 3R' and the cylinder 4 require much space, especially since the sliding core parts slide from side to side. The Federal Circuit has stated that, generally, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. *See In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Budinski et al. teaches away from being modified as proposed in the Office Action and one of ordinary skill in the art would not make such a modification to Budinski et al.

Accordingly, for the aforementioned reasons, claims 5 and 6 are patentable over the cited art. Claim 2 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

New claims 7-20 have been added and are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claims 7-18 are further patentable because Budinski et al. in view of Shimizu et al. does not disclose or suggest all the limitations of claims 7-18¹. For example, claims 12 and 18 recite that the intermediate restrictor is positioned to

¹In the case of claims 9 and 15, modifying the relative shapes of the molding cores of Budinski et al. to be the same as Shimizu et al. would make the cited art distinguishable over claims 9 and 15.

restrict the flow of the lens preform during heating and compressing to mold the lens preform to closely conform to each of the depressions or projections to homogenize the optical performance of lens elements disposed in a central area of the lens preform and lens elements disposed in a peripheral area of the lens preform. Budinski et al. in view of Shimizu et al. fails to disclose or suggest this limitation². The intermediate restrictor of the present invention is restricting the flow of the lens preform while ringed space 5A in Shimizu et al. is provided as an escape space for the glass element. Thus, the functions of the molding space of the claimed invention and of Shimizu et al. are different. Moreover, the intermediate restrictor of the claimed invention has the function of making the lenses in the central area and peripheral area to have the same optical performance. The Office Action has not provided evidence of such function being found in Budinski et al. in view of Shimizu et al. There Office Action has identified no disclosure or suggestion that in Budinski et al. in view of Shimizu et al. that the sliding core parts disclosed in Shimizu et al. serve to restrict the flow of the lens preform. The Office Action has also not identified any disclosure or suggestion in Budinski et al. in view of Shimizu et al. that the lens preform of Budinski et al. is being compressed until it exits the sides of the molds (in order to be blocked by any

²Claims 19 and 20 are also patentable for similar reasons since the Budinski et al. in view of Shimizu et al. fails to disclose or suggest the homogenization of the performance of the lens elements.

sliding core parts) and no reason has been provided for doing so. Furthermore, the Office Action provides no evidence for any restriction of the flow of the glass preform in Budinski et al. in view of Shimizu et al. such that the performance of the lens elements is homogenized. Accordingly, claims 12 and 18 (and claims 19 and 20) are further patentable for this reason as well.

Claims 5 and 6 have been amended to place them in better form and to clarify the invention. New claims 7-18 have been added. Support for the claim amendments and for the new claims can be found in, for example, Figure 3, Figure 4, and the first full paragraph of page 3 of the specification.

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

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